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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/928,599  
Filing Date: August 13, 2001  
Appellant(s): KOWALSKI, LEE ANNE

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Lee Anne Kowalski  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed February 19, 2009 appealing from the Office action mailed September 19, 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,009,442	Chen et al.	12-1999
5,825,854	Larson et al.	10/1998

Padwick et al. "Special Edition Using Microsoft Outlook 2000" (Que Publishing, 12 May 1999) chapter 22 pp. 1-19.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 4-16, 19-23, 26-38, 41-45, 48-60 and 63-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padwick et al. (hereinafter "Padwick"), Special Edition Using Microsoft Outlook 2000 (Que Publishing, 12, May, 1999), in view of Chen et al. (hereinafter "Chen"), U.S. Patent No. 6,009,442 of record.**

*Claim 1:*

Padwick discloses *a computer-implemented method for identifying and distinguishing words contained within an electronic message* (see Chapter 22 –

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Creating and Using Rules, *“Using the Rules Wizard to Manage Incoming Messages”*

Pages 1-19 of 19 → Padwick discloses this limitation in that Outlook includes an “Rules Wizard” tool that allows the user to search emails for a particular term or phrase),  
*comprising the steps of:*

- *creating and reading electronic messages in an electronic messaging application performed by a computer* (Padwick discloses this limitation in that Outlook allows the user to create and read emails), *wherein the electronic messaging application sends an electronic message from an originator to a recipient via a network* (Padwick discloses this limitation in that Outlook sends emails created by the user to a recipient via a computer network), *and the electronic messaging application identifies certain words that are contained within the electronic message* (as explained in the immediately following discussion, Padwick discloses this limitation) *by performing the steps of:*
  - *comparing message terms in an electronic message to significant terms stored by the computer in an online registry to identify any of the message terms in the electronic message that match the significant terms stored in the online registry* (see Figure 22.15; see Pages 1-15 of 19 → Padwick discloses this limitation in that the “Rules Wizard” tool allows the user to create rules to filter emails based on whether user-specified terms are in the emails. Every rule created is stored on the computer, so that the rules may be subsequently applied to emails. Thus, the user-specified terms are “stored” by an “online registry.”); *and*

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- *identifying the matched message terms and indicating their significance to a reader by sending electronic messages that include any matched significant message terms to a folder* (see Figure 22.15; see Pages 1-15 of 19 → Padwick discloses this limitation in that the “Rules Wizard” tool allows the user to specify that emails satisfying a rule are moved to a particular folder. By moving emails that include user-specified terms to a particular folder, Padwick “*identifies the matched message terms*” and “*indicates their significance to a reader.*”).

Padwick fails to expressly disclose:

- *the electronic messaging application **distinguishing** certain words that are contained within the electronic message by performing the step of:*
    - ***making alterations** to the electronic message to identify the matched message terms and to indicate their significance to a reader*
- (EXAMINER’S INTERPRETATION – These two phrases (i.e., “*an application that distinguishes certain words*” and “*making alterations to the electronic message*” essentially recite the same subject matter. That is, these limitations recite: an “*electronic messaging application*” that automatically “*distinguishes*” certain words in a “*message*” by “*making alterations*” to those words for the purpose of indicating the significance of those words to a reader of the “*message.*”), *wherein the alterations are*

*made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient.*

Chen teaches *a computer-implemented method for identifying and distinguishing words contained within an electronic message* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), *comprising:*

- *an electronic messaging application distinguishing certain words that are contained within the electronic message* (as explained in the immediately following discussion, Chen teaches this limitation) *by performing the step of:*
  - *making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader, wherein the alterations are made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient* (see Figure 1B; see Column 3, Line 37 through Column 4, Line 5; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for

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the user-specified keywords within the emails. When a user-specified keyword is detected in an email, the system designates the email for storage in a user-specified folder. In this way, the system “alters the email.” Subsequently, when the email is viewed by the user, the system highlights the user-specified keyword. By highlighting the user-specified keywords, Chen “*identifies matched message terms*” and “*indicates their significance to a reader.*” Additionally, the system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches “*altering the electronic message when authored by its originator or received by its recipient.*”),

for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of:

- *an electronic messaging application distinguishing certain words that are contained within the electronic message by performing the step of:*
  - *making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader, wherein the alterations are made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient,*



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for the purpose of calling the user's attention to the user-specified keywords, as taught in Chen.

*Claim 4:*

Padwick discloses *significant terms that are determined based upon a reader profile* (see Chapter 22 – Creating and Using Rules; “*Using the Rules Wizard to Manage Incoming Messages*” and “*Creating Rules for Outgoing Messages*” → Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create rules for processing incoming emails for the “*reader*”; these rules comprise the “*reader profile*” that determines the “*significant terms*”).

Padwick fails to expressly disclose *an electronic message that is altered when received*.

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), *comprising the step of:*

- *altering the electronic message when received* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column

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8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches *“altering the electronic message when received.”*); for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of *altering the electronic message when received*, for the purpose of calling the user’s attention to the user-specified keywords, as taught in Chen.

*Claim 5:*

Padwick discloses *significant terms that are determined based upon an author profile* (Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create rules for processing outgoing emails for the “author”; these rules comprise the *“author profile”* that determines the *“significant terms”*).

Padwick fails to expressly disclose *an electronic message that is altered when authored*.

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), *comprising the step of:*

- *altering the electronic message when authored* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches “*altering the electronic message when authored*.”);

for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include

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the step of *altering the electronic message when authored*, for the purpose of calling the user's attention to the user-specified keywords, as taught in Chen.

*Claim 6:*

Padwick fails to expressly disclose:

- *matched message terms that are identified based upon a reader profile, wherein the electronic message is altered when received.*

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), *comprising the step of:*

- *matched message terms that are identified based upon a reader profile, wherein the electronic message is altered when received* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches

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*“matched message terms that are identified based upon a reader profile” and “altering the electronic message when received.”),*  
for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of:

- *matched message terms that are identified based upon a reader profile, wherein the electronic message is altered when received,*

for the purpose of calling the user’s attention to the user-specified keywords, as taught in Chen.

*Claim 7:*

Padwick fails to expressly disclose/teach:

- *matched message terms that are identified based upon a author profile, wherein the electronic message is altered when authored.*

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the

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document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), *comprising the step of:*

- *matched message terms that are identified based upon a author profile, wherein the electronic message is altered when authored* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches “*matched message terms that are identified based upon an author profile*” and “*altering the electronic message when authored.*”);

for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick to include the step of:

- *matched message terms that are identified based upon a author profile, wherein the electronic message is altered when authored,*

for the purpose of calling the user’s attention to the user-specified keywords, as taught in Chen.

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*Claim 8:*

Padwick discloses *the step of collecting and storing significant terms in the online registry* (see Chapter 22 – Creating and Using Rules; “*Using the Rules Wizard to Create Rules that Manage Incoming Messages*” Pages 1-19 of 19 and “*Creating Rules for Outgoing Messages*” Pages 1-2 of 2 → Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create and save rules for searching incoming or outgoing emails for particular terms. Thus, the rules constitute an “*online registry*” of “*significant terms*.”).

*Claim 9:*

Padwick discloses a *step of collecting and storing [that] comprises a user selecting significant terms* (Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create and save rules for searching incoming or outgoing emails for particular terms; thus, the user “*selects significant terms*”).

*Claim 10:*

Padwick discloses a *step of collecting and storing comprises importing significant terms* (see Chapter 22 – Creating and Using Rule; “*Managing Rules*” → Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file).

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*Claim 11:*

Padwick discloses *significant terms are imported from an address book* (Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file; a “file” includes an address book).

*Claim 12:*

Padwick discloses *significant terms are imported from a database* (Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file; a “file” includes a database).

*Claim 13:*

Padwick discloses *significant terms comprise names of people, product terms or key words in a user’s field* (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms, which may include “names of people”; for example, see Figure 28.4).

*Claims 14-16:*

Padwick, in view of Chen, fails to expressly disclose:

- *making alterations to the electronic message comprises making the matched message terms a different color, a different font effect, or a different font type.*

However, selecting a particular color, font effect, or font type for displaying the located search terms was a design choice that was well known by one of ordinary skill



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in the art at the time the invention was made. Chen expressly taught "highlighting" the located search terms, but did not disclose the particular color in which the term is highlighted and whether the color, font effect, and/or font type could be changed by the user. Changing the font effect, font type, and/or color of text in an electronic document was well known at the time the invention was made by even ordinary computer users. At the time the invention was made, those of ordinary skill in the art (e.g., computer programmers) would have known how to design a search tool so a user could select the particular color, font effect, and/or font type in which the located search term was displayed for the purpose of facilitating aesthetics.

Additionally, Padwick disclosed a Rules Wizard that allowed the user to compose multiple processing rules that are applied to each sent email. Thus, two rules could have been written to locate two different search requests for sent emails and display each located term in different colors, font effects, and/or font types, for the purpose of distinguishing the different search requests within each email.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Chen, to include making alterations to the electronic message comprises making the matched message terms a different color, a different font effect, or a different font type, for the purposes of aesthetics and distinguishing the different search requests within each email.

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*Claim 19:*

Padwick discloses *identifying where the alterations to the matched message terms*, taught by Chen, *[is to be] performed according to a user setting* (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms; thus, making the search term “distinct” is performed “according to a user setting”).

*Claim 20:*

Padwick discloses *significant terms [that] are categorized and the user setting is based upon a category of the significant term* (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms and process email messages containing each different search term in a particular way. For example, Outlook can search for all emails that include the term “deadline” and send those emails to a certain folder, or Outlook can search for all emails that include the term “office party” and delete those emails. Thus, the significant terms are “categorized” and the user setting processes emails having the significant terms “*based on a category of the significant term.*”).

*Claim 21:*

Padwick fails to expressly disclose *displaying the electronic message if the end of the electronic messages as been reached.*

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 → Chen teaches this limitation in that the computer-based document management system allows a user to define criteria comprising key terms, wherein the system identifies documents - including email messages - that satisfy the user-specified criteria and, when displaying those documents to the user, highlights the key terms), *comprising the step of:*

- *displaying the electronic message if the end of the electronic messages as been reached* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 – Chen teaches this limitation in that the computer-based document management system allows the user to click on any document in a list of documents meeting the user-specified criteria and, upon selection of one of the listed documents by the user, displays the document with the highlighted search term, Thus, the system has scanned the document for the significant term and displays the document “*if the end of the electronic messages as been reached.*”),

for the purpose of calling the user’s attention to the portion(s) of the displayed document that contain the key terms.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the *step of displaying the electronic message if the end of the electronic messages as*

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*been reached* for the purpose of calling the user's attention to the portion(s) of the displayed document that contain the key terms, as taught in Chen.

*Claim 22:*

Padwick fails to expressly disclose *querying a user before making alterations to the electronic message*.

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 → Chen teaches this limitation in that the computer-based document management system allows a user to define criteria comprising key terms, wherein the system identifies documents - including email messages - that satisfy the user-specified criteria and, when displaying those documents to the user, highlights the key terms), *comprising the step of:*

- *querying a user before making alterations to the electronic message* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 → Chen teaches this limitation in that the computer-based document management system allows the user to search documents for particular terms and distinctly displays those terms when one of the documents meeting the user-specified criteria is displayed. Thus, the system “*queries the user before making alterations to the electronic message.*”),

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for the purpose of calling the user's attention to the portion(s) of the displayed document that contain the key terms.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the *step of querying a user before making alterations to the electronic message*, for the purpose of calling the user's attention to the portion(s) of the displayed document that contain the key terms, as taught in Chen.

*Claims 23, 26-38 and 41-44:*

These claims merely recite an apparatus for performing the method of Claims 1, 4-16 and 19-22. Padwick discloses and Chen teaches computer systems.

Thus, Claims 23, 26-38 and 41-44 remain rejected using the same rationale used in the above rejections for Claims 1, 4-16 and 19-22, respectively.

*Claims 45, 48-60 and 63-66:*

These claims merely recite computer software for performing the method of Claims 1, 4-16 and 19-22. Both Padwick and Chen operate via computer software.

Thus, Claims 45, 48-60 and 63-66 remain rejected using the same rationale used in the above rejections for Claims 1, 4-16 and 19-22, respectively.

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**Claims 17, 18, 39, 40, 61 and 62 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Padwick, in view of Chen, and further in view of Larson et al., U.S. Patent No. 5,825,854.**

*Claim 17:*

As indicated in the above discussion, Padwick, in view of Chen, discloses/teaches every limitation of Claim 1.

Padwick, in view of Chen, fails to expressly disclose:

- *inserting an object into the electronic message near the matched message term.*

Larson teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 → Larson teaches this limitation in that the telephone access system to audibly highlight a word that is graphically highlighted in an electronic message), *comprising the steps of:*

- *inserting an object into the electronic message near the highlighted message term* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 → Larson teaches this limitation in that the telephone access system inserts an audio file at a highlighted term in an electronic message),

for the purpose of audibly notifying a user of highlighted text within an electronic message when the user accesses the message via a telephone.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Chen, to include *inserting an object into the electronic message near the matched message term*, for the purpose of audibly notifying a user of highlighted text within an electronic message when the user accesses the message via a telephone, as taught by Larson.

*Claim 18:*

Padwick, in view of Chen, fails to expressly disclose:

- *an object that comprises an image, a sound file, an icon, a link or a video.*

Larson teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 → Larson teaches this limitation in that the telephone access system to audibly highlight a word that is graphically highlighted in an electronic message), *comprising the steps of:*

- *selecting an object that comprises an image, a sound file, an icon, a link or a video* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 → Larson teaches this limitation in that the telephone access system inserts an audio file at a highlighted term in an electronic message),

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for the purpose of audibly notifying a user of highlighted text within an electronic message when the user accesses the message via a telephone.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Chen, to include *selecting an object from the group consisting of an image, a sound file, an icon, a link and a video*, for the purpose of audibly notifying a user of highlighted text within an electronic message when the user accesses the message via a telephone, as taught by Larson.

*Claims 39 and 40:*

These claims merely recite an apparatus for performing the method of Claims 17 and 18. Padwick discloses and both Chen and Larson teach computer systems.

Thus, Claims 39 and 40 remain rejected using the same rationale used in the above rejections for Claims 17 and 18, respectively.

*Claims 61 and 62:*

These claims merely recite computer software for performing the method of Claims 17 and 18. Padwick, Chen and Larson operate via computer software.

Thus, Claims 61 and 62 remain rejected using the same rationale used in the above rejections for Claims 17 and 18, respectively.



**(10) Response to Argument**

Independent claims 1, 23 and 45

Appellant notes that the rejections based on Padwick-Outlook 2000 and Chen were last presented in the Office Action dated November 29, 2005, were previously overcome in the response filed by the Appellant dated February 27, 2006, as acknowledged by the rejections' absence in the Office Action dated April 25, 2006. (See Brief Response page 16)

Examiner respectfully disagrees.

Examiner submits that changing the combination of references from Padwick-Outlook 2000 and Chen to Padwick-Outlook 2002 and Chen does not explicitly acknowledge that the Appellant has overcome the Padwick-Outlook 2000 and Chen references. Examiner notes that the subject matter previously relied upon in Padwick, Outlook 2002 in Action dated 11/13/2007 before being eliminated by Appellant's submission of Declarations under 37 C.F.R. 1.131 is substantially the same subject matter relied upon in Padwick, Outlook 2000. Therefore, in respect to the relied upon subject matter, Padwick-Outlook 2000 and Padwick-Outlook 2002 are interchangeable. Thus, Examiner has never explicitly or implicitly acknowledged that the Appellant has sufficiently overcome the applied rejections based on Padwick-Outlook 2000 and Chen.

Appellant argues that the combination of Padwick-Outlook 2000 and Chen fail to teach or suggest **making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader, wherein the alterations are made by an electronic messaging application when the electronic message is authored by its originator or received by its recipient.** Chen explicitly states that emails or other documents must be imported into its document management system. See, col. 3, 37-59 of Chen. Moreover, Chen's document management system is not an electronic messaging application. Consequently, Chen does not make the alterations when the electronic message is authored by its originator or received by its recipient. Instead, Chen teaches functions that are performed only when the email has been imported into the document management system (See Brief Response p. 16-17).

Examiner respectfully disagrees.

Chen explicitly recites “A *category* is a logical grouping of documents that share some common attribute or attributes, sometimes referred to as **category criteria**. For example, **a category may consist of** a number of documents that share a common author, a number of documents that contain at least a predefined number of words, **a number of documents that contain certain key words**, or a number of documents that share a common concept” (see col. 7 lines 5-15). (emphasis added)

Chen explicitly recites *"The document viewing utility 169 also **highlights category criteria**. In other words, **its highlights the various keywords, phrases, and/or attributes in the document being viewed, which make up the category criteria**, assuming, of course, the document has been categorized"* (see col. 15 lines 22-26).

In light of the two passages above, Chen does teach **making alterations** (e.g. highlighting keywords) **to the electronic message** (i.e., document) **to identify the matched message terms** (i.e., matched keywords found in both category criteria and document are highlighted or identified in the document) **and to indicate their significance to a reader**, (i.e., highlighted keywords of the document indicate significance of the category criteria to a reader) **wherein the alterations are made by an electronic messaging application** (i.e., highlighting is made by the document management system) **when the electronic message is authored by its originator** (Examiner notes that all documents are authored by an originator, therefore this particular limitation reads on all documents) **or received by its recipient** (Examiner notes that the person using the utility to view document may be its recipient).

Appellant alleges that Chen's document management system is not an electronic messaging application. However, Chen's document management system is capable of performing the functions of the claimed "electronic messaging application." For example, Chen's document management system is also capable of sending documents as emails (see col. 9 lines 10-12, col. 12 lines 4-10). Therefore, the claimed "electronic

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messaging application” is not patentably distinguishable over Chen's document management system.

Dependent claims 4, 26 and 48

With regard to dependent claims 4, 26 and 48, which recite that ***“the significant terms are determined based upon a reader profile wherein the electronic message is altered when received,”*** the Office Action cites Padwick-Outlook 2000 as teaching a Rules Wizard that allows a user to create rules for processing messages and Chen as disclosing a message that is altered when received. Appellant's attorney submits that these functions are performed independently by the references, and that, even when combined, a rule performed by Padwick-Outlook 2000 would not cause Chen to alter a message. Thus, the combination of Padwick-Outlook 2000 and Chen do not teach or suggest these claims. (See Brief Response p. 17).

Examiner respectfully disagrees.

Padwick discloses *significant terms that are determined based upon a reader profile* (see Chapter 22 – Creating and Using Rules; “*Using the Rules Wizard to Manage Incoming Messages*” and “*Creating Rules for Outgoing Messages*” → Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create rules for processing incoming emails for the “*reader*”; these rules comprise the “*reader profile*” that determines the “*significant terms*”).

Padwick fails to expressly disclose *an electronic message that is altered when received*.

Chen teaches keywords (i.e., significant terms) are determined based upon a category criteria (i.e., "reader profile") wherein the electronic message is altered (e.g. document keywords are highlighted) when viewed (i.e., received by the viewer). (see col. 7 lines 5-15, col. 15 lines 22-26).

The references are at least combinable because the documents in Padwick can be imported into the Chen document management system. Therefore, Chen can perform the recited feature as explained above.

Also, Examiner submits it would have been obvious to one of ordinary skill in the art at the time the invention for the processed electronic messages as taught by Padwick to contain highlighted keywords (i.e., alterations) as taught by Chen to provide the benefit of indicating significant keywords within the electronic messages.

Dependent claims 5, 27 and 49

With regard to dependent claims 5, 27 and 49, which recite that ***"the significant terms are determined based upon an author profile wherein the electronic message is altered when authored,"*** the Office Action cites Padwick-Outlook 2000 as teaching a Rules Wizard that allows a user to create rules for processing messages and Chen as disclosing a message that is altered when authored. Appellant's attorney submits that these functions are performed independently by the references, and that,

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even when combined, a rule performed by Padwick-Outlook 2000 would not cause Chen to alter a message. Thus, the combination of Padwick-Outlook 2000 and Chen do not teach or suggest these claims. (See Brief Response p. 18)

Examiner respectfully disagrees.

Padwick discloses *significant terms that are determined based upon an author profile* (Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create rules for processing outgoing emails for the “author”; these rules comprise the “*author profile*” that determines the “*significant terms*”).

Padwick fails to expressly disclose *an electronic message that is altered when authored*.

Chen teaches keywords (i.e., significant terms) are determined based upon a category criteria (i.e., “author profile”) wherein the electronic message is altered (e.g. document keywords are highlighted) when authored (Examiner notes that all electronic documents must be authored by an originator) (see col. 7 lines 5-15, col. 15 lines 22-26).

The references are at least combinable because the documents in Padwick can be imported into the Chen document management system. Therefore, Chen can perform the recited feature as explained above.

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Also, Examiner submits it would have been obvious to one of ordinary skill in the art at the time the invention for the processed electronic messages as taught by Padwick to contain highlighted keywords (i.e., alterations) as taught by Chen to provide the benefit of indicating significant keywords within the electronic messages.

Dependent claims 6, 28 and 50

With regard to dependent claims 6, 28 and 50, which recite that ***"the matched message terms are identified based upon a reader profile wherein the electronic message is altered when received,"*** the Office Action cites Chen as disclosing that a document management system highlights keywords within a message. Appellant's attorney submits that nowhere does Chen refer to a reader profile or the alteration of a message within an electronic messaging application when the message is received. Thus, Chen does not teach or suggest these claims. (See Brief Response p. 18)

Examiner respectfully disagrees.

Chen teaches a category criteria which may be consider to be a "reader profile" because the category criteria contains significant terms and settings that is applied to a electronic document to identify matched message terms (see col. 7 lines 5-15, col. 15 lines 22-26).

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Chen teaches highlighting keywords (alteration of a message) within a document management system (i.e., electronic messaging application) when the document (e.g. message) is viewed (i.e. received by a viewer) (see col. 7 lines 5-15, col. 15 lines 22-26).

As explained above, the claimed "electronic messaging application" is not patentably distinguishable over Chen's document management system. For example, Chen's document management system is also capable of sending documents as emails (see col. 9 lines 10-12, col. 12 lines 4-10).

Dependent claims 7, 29 and 51

With regard to dependent claims 7, 29 and 51, which recite that ***"the matched message terms are identified based upon an author profile wherein the electronic message is altered when authored,"*** the Office Action cites Chen as disclosing that a document management system highlights keywords within a message. Appellant's attorney submits that nowhere does Chen refer to an author profile or the alteration of a message within an electronic messaging application when the message is authored. Thus, Chen does not teach or suggest these claims. (See Brief Response p. 18)



Examiner respectfully disagrees.

Chen teaches a category criteria which may be consider to be an “author profile” because the category criteria contains significant terms and settings that is applied to a electronic document to identify matched message terms (see col. 7 lines 5-15, col. 15 lines 22-26).

Chen teaches highlighting keywords (alteration of a message) within a document management system (i.e., electronic messaging application) when the document (e.g. message) is authored (Examiner notes that all electronic documents must be authored by an originator) (see col. 7 lines 5-15, col. 15 lines 22-26).

As explained above, the claimed “electronic messaging application” is not patentably distinguishable over Chen's document management system. For example, Chen's document management system is also capable of sending documents as emails (see col. 9 lines 10-12, col. 12 lines 4-10).

Dependent claims 8-16, 19-22, 30-38, 41-44, 52-60 and 63-66

With regard to dependent claims 8-16, 19-22, 30-38, 41-44, 52-60 and 63-66, these claims stand or fall with independent claims 1, 23 and 45, respectively. (See Brief Response p. 18)

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Dependent claims 17, 39 and 61

With regard to dependent claims 17, 39 and 61, which recite that ***"making alterations to the electronic message comprises inserting an object into the electronic message near the matched message term,"*** the Office Action cites Larson as disclosing that a telephone access system that inserts an audio file at a highlighted term in an electronic message. Appellant's attorney notes that nowhere does Larson refer to inserting an audio file at a highlighted term in an electronic message. Thus, Larson does not teach or suggest these claims. (See Brief Response p. 19)

Examiner respectfully disagrees.

Larson teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 → Larson teaches this limitation in that the telephone access system to audibly highlight a word that is graphically highlighted in an electronic message), *comprising the steps of:*

- *inserting an object into the electronic message near the highlighted message term* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 → Larson teaches this limitation in that the telephone access system inserts an audio file at a highlighted term in an electronic message),

for the purpose of audibly notifying a user of highlighted text within an electronic message when the user accesses the message via a telephone.

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Dependent claims 18, 40, and 62

With regard to dependent claims 18, 40, and 62, these claims stand or fall with independent claims 17, 39 and 61, respectively. (See Brief Response p. 18)

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Henry Orr/

Conferees:

/DOUG HUTTON/

Supervisory Patent Examiner, Art Unit 2176

/Stephen S. Hong/

Supervisory Patent Examiner, Art Unit 2178